

REMARKS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 1, 3-6, 23 and 26-31 are pending in the present application. Claim 26 and 27-30 have been amended to address the formal matters raised in the outstanding Official Action.

In the outstanding Official Action, the disclosure was objected to for allegedly not containing a "Brief Description of the Drawings" section. However, at this time, applicants note that page 12 of the present specification already contains such a section. As a result, applicants believe the present amendment obviates this rejection.

Claims 1 and 23 were rejected under 35 USC §112, first paragraph, for allegedly not satisfying the enablement requirement. This rejection is respectfully traversed.

In imposing the rejection, the Official Action contends that even minor variations in structural formula can lead to major differences in the activity of erythromycin derivatives. As a result, the Official Action alleges that one of ordinary skill in the art at the time the invention was made would not expect that the claimed compounds, which have major structural differences, to possess similar activities.

However, at this time, the Examiner's attention is respectfully directed to Table 1 in the present specification.

In Table 1, indicated activity is represented in comparison with enhancing action for differentiation-induction of EM 100 μ M.

Upon viewing Table 1, it is believed to be apparent that the present specification demonstrates that a variety of compounds that fall within the scope of the claimed invention induce differentiation-induction of a monocyte to a macrophage.

As Table 1 shows that minor variations can occur yet still provide a compound with the recited properties, applicants believe that the Official Action fails to satisfy its burden in showing that the claimed invention is not fully supported by the present disclosure.

Moreover, the Examiner is respectfully reminded that it is a well founded principle that any assertion by the Patent Office that the enabling disclosure is not commensurate in scope with the protection sought must be supported by evidence or reasoning substantiating the doubt so expressed.

As a matter of law, the expressed teaching of the patent specification cannot be controverted by mere speculation and unsupported assertions on the part of the Patent Office. As stated by the Court of Customs and Patent Appeals in the case of *In re Dinh-Nguyen and Stanhagen*, 181 USPQ 46 (CCPA 1974) :

Any assertion by the Patent Office that the enabling disclosure is not commensurate in scope with the protection sought must be supported by evidence or reasoning substantiating the doubt so expressed. 181 USPQ at 47.

Such a standard must be applied with great care when the Examiner's conjecture is contrary to the teachings of the specification.

In view of the above, applicants believe that the Official Action does not satisfy its burden in showing that claims 1 and 23 are not enabled.

Furthermore, the presence of inoperative embodiments within the scope of a claim does not necessarily render a claim nonenabled. Rather, the standard is whether a skilled person could determine which embodiments that were conceived, but not yet made, would be inoperative or operative with expenditure of no more effort than is normally required in the art. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1577, 224 USPQ 409, 414 (Fed. Cir. 1984).

As to the present application, applicants note that the Office Action does not identify any potentially inoperative embodiments within the scope of the claims. Moreover, the Office Action does not provide evidence to show that one skilled in the art would have to expend more effort than is normally required in the art or that the quantity of such experimentation would be an undue burden.

In view of the above, applicants respectfully request that the enablement rejection be withdrawn.

Claims 3-6 and 26-30 were rejected under 35 USC §112, second paragraph, for allegedly being indefinite for failing to

particularly point and distinctly claim the subject matter which applicants regard as the invention. Applicants believe the present amendment obviates this rejection.

In imposing the rejection, the Official Action alleges that the term "ally" is indefinite. Moreover, the Official Action states that claims 27-30 are substantial duplicates of claims 3-6, respectively.

However, claim 26 has been amended to delete the term "ally" and insert the term --allyl--. As to claims 27-30, claims 27-30 have been amended so that they are now dependent on claim 31.

As a result, applicants believe the present amendment obviates this rejection. Indeed, at this time, applicants believe at the very least, the changes to the claims place the application in better condition for appeal as they are believed to obviate the §112, second paragraph issue. Thus, applicants respectfully request that the present amendment be entered for purposes of appeal.

Claims 1, 3, 4, 23, 26-28 and 31 were rejected under 35 USC §103(a) as allegedly being unpatentable over HOELTJE et al. aor GIDDA et al. or KIRST et al. Claims 1, 5, 6, 23, 26 and 29-31 were rejected under 35 USC §103(a) as allegedly being unpatentable over HOELTJE et al. These rejections are respectfully traversed.

In imposing the rejections, the Official Action alleges that applicants do not provide any evidence that shows that the claimed compounds promote the differentiation-induction of monocytes to macrophages.

However, as noted above, applicants note that Table 1 shows that a number of compounds encompassed by the claimed invention exhibits differentiation-induction of monocytes to macrophages. Indeed, applicants note that claims 3-6 correspond to compounds EM722, EM723, EM730 and EM731, respectively. Each of these compounds exhibit the ability to differentiate-induce a monocyte to a macrophage. Thus, in view of the above, applicants believe that the above-identified publications, alone or in combination with each other, fail to disclose or suggest the claimed invention.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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